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EXAMINER

ENG, GEORGE

ART UNIT PAPER NUMBER

2643

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/019,787

Applicant(s)

BAYASSI, MULHAM

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 1/4/2002 (paper no. 2) has been considered.

### ***Response to Preliminary Amendment***

3. This Office action is in response to the preliminary amendment filed 1/4/2002 (paper no.
- 4). Accordingly, claims 1-48 are pending for the examination and claims 49-50 are canceled.

### ***Specification***

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program

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listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recited a single method step of transmitting a notification message in a broadcast signal; claim 19 recited a single method step of transmitting a notification message indicating the receipt of e-mail by the mail center to the user via a second medium different from the first medium; claim 22 recited a single method step of transmitting at least part of the e-mail in a

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broadcast signal; claim 22 recited a single method step of running an e-mail application on a receiver; claim 24 recited a single means for transmitting a notification message in a broadcast signal; claim 38 recited a single means for transmitting at least part of the e-mail in a broadcast signal; claim 39 recited a single means for transmitting a notification message indicating the receipt of e-mail by the mail center to the user via a second medium different from the first medium; claim 41 recited a single means for receiving together with a broadcast signal a notification message for notifying a user of the receipt of e-mail by a mail center; and claim 46 recited a signal means for receiving a notification message indicating the receipt of e-mail by the mail center via a second medium different from the first medium, but each claim does not appear in combination with another recited steps or means, therefore it is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). The present claims depend on a single recited step or means, a fact situation comparable to Hyatt, where the claims cover every conceivable structure for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Therefore, the specification is non-enabling for failing to disclose all possible means, methods for performing the stated function.

Accordingly, dependent claims 2-18, 20-21, 25-37, 40, 42-45 and 47 are also rejected for the same reasons since they are dependent on a rejected base claims and contain the same problem(s).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 41-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 41 and 46, the term “and/or” render the claim vague and indefinite because it has an alternative meaning, which does not positive identify the claimed limitations.

Claims 42-45 and 47 are also rejected because of depending on claims 41 and 46, respectively, containing the same deficiency.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-5, 9-13, 16-25, 29-31 and 34-48 are rejected under 35 U.S.C. 102(a) as being anticipated by Oi (JP 10-210072 A).

Regarding claims 1-2, Oi discloses a method of notifying a user of the receipt of an e-mail by a mail center (2, figure 1) comprising transmitting a notification message in a broadcast signal, wherein the notification message is sent without user prompt (abstract).

Regarding claim 3-5, Oi teaches the notification message including an identifier of a receiver (6, figure 1) to which the notification to be sent and the receiver compares the identifier

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with stored identifier, i.e., a smart card number, at the receiver (detailed description, paragraphs [0024] and [0035]).

Regarding claims 9-11, Oi discloses the notification message comprising an identifier of the recipient of the e-mail, an identifier of the sender of the e-mail and at least part of the ext of the e-mail (detailed description, paragraphs [0024] and [0062]).

Regarding claims 12-13, Oi clearly discloses the notification message being sent to a receiver (6, figure 1), wherein the receiver generates a signal for indicating to the user receipt of the e-mail by the mail center (detailed description, paragraph [0039]).

Regarding claims 16-18, Oi discloses that the broadcast signal is a digital data stream, wherein the notification is sent as a section of the digital data stream by way of an entitlement management message (detailed description, paragraphs [0041] through [0043] and paragraph [0046]).

Regarding claim 19, Oi disclose a method of notifying a user (i.e. user A) of the receipt of e-mail by a mail center (2, figure 1), which e-mail id to be transmitted to the user via a first medium (i.e., a terminal unit 4, figure 1), comprising transmitting a notification message, indicating the receipt of e-mail by the mail center to the user via a second medium (i.e., a television 7, figure 1), different from the first medium (abstract and detailed description, paragraphs [0020] through [0024]).

Regarding claim 20, Oi discloses that the first medium is a switched medium and the second medium is a broadcast medium (figure 1 and detailed description, paragraphs [0023] and [0024]).

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Regarding claim 21, Oi teaches to transmit at least part of the e-mail in the broadcast signal (detailed description, paragraph [0062]).

Regarding claim 22, the limitations of the claim are rejected as the same reasons set forth in claim 21.

Regarding claim 23, Oi discloses a method of communicating with a mail center (2, figure 1) comprising running an e-mail application on a receiver (abstract and detailed description, paragraph [0035]).

Regarding claim 24, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 25, the limitations of the claim are rejected as the same reasons set forth in claims 3-5.

Regarding claims 29-31, the limitations of the claims are rejected as the same reasons set forth in claims 9-11.

Regarding claims 34-36, the limitations of the claims are rejected as the same reasons set forth in claims 16-18.

Regarding claim 37, the limitations of the claim are rejected as the same reasons set forth in claim 21.

Regarding claim 38, the limitations of the claim are rejected as the same reasons set forth in claim 21.

Regarding claim 39, the limitations of the claim are rejected as the same reasons set forth in claim 19.



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Regarding claim 40, the limitations of the claim are rejected as the same reasons set forth in claim 20.

Regarding claim 41, Oi discloses a receiver (6, figure 1) for receiving and decoding a broadcast signal comprising means for receiving a notification message for notifying a user of the receipt of e-mail by a mail center (4, figure 1) together with a broadcast signal (abstract and detailed description, paragraphs [0035] through [0041]).

Regarding claims 42-43, the limitations of the claims are rejected as the same reasons set forth in claims 3-5.

Regarding claim 44, Oi teaches the receiver generates a signal indicating the receipt of e-mail by the mail center (abstract and detailed description, paragraph [0035]).

Regarding claim 45, Oi discloses the receiver generating a signal for displaying at least part of the notification message (detailed description, paragraph [0062]).

Regarding claim 46, Oi discloses a receiver for receiving and decoding a broadcast signal comprising means for receiving e-mail via a first medium and means for receiving a notification message indicating the receipt of e-mail by the mail center, via a second medium different from the first medium (abstract and detailed description, paragraphs [0020] through [0024]).

Regarding claim 47, the limitations of the claim are rejected as the same reasons set forth in claim 20.

Regarding claim 48, Oi discloses a system for notifying a user of the receipt of e-mail comprising an apparatus (3, figure 1) for notifying a user of the receipt of e-mail by a mail center (2, figure 1) and a receiver (6, figure 1) for receiving and decoding a broadcast signal, the apparatus comprising means (26, figure 1) for transmitting a notification message in the

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broadcast signal, and the receiver comprising means for receiving a notification message for notifying the user of the receipt of e-mail by the mail center together with the broadcast signal (abstract and the entire detailed description).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6-8 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oi (JP 10-210072 A) in view of Bosco (US PAT. 6,335,963).

Regarding claims 6-8, Oi differs from the claimed invention in not specifically teaching to store information related to e-mail account preferably at a central location, wherein information related to e-mail account is linked to identifiers of receivers or the smart card numbers of the receivers, and wherein the broadcast signal is part of a subscription service and information relating to e-mail accounts is linked to information relating to the subscription service. However, Bosco discloses a system for providing notification of a received electronic mail message comprising a database at a central location for storing information related to e-mail accounts linked with unique ID and what to send information, i.e., identifiers of receivers or smart card numbers of the receivers, wherein the broadcast signal is part of a subscription service and information relating to e-mail accounts is linked to information relating to the subscription

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service in order to enhance the system to notify or alert a user consistent with the user's subscription (col. 2 line 58 through col. 5 line 25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oi in storing information related to e-mail account preferably at a central location, wherein information related to e-mail account is linked to identifiers of receivers or the smart card numbers of the receivers, and wherein the broadcast signal is part of a subscription service and information relating to e-mail accounts is linked to information relating to the subscription service, as per teaching of Bosco, in order to enhance the system to notify or alert a user consistent with the user's subscription.

Regarding claims 26-28, the limitations of the claims are rejected as the same reasons set forth in claims 6-8.

13. Claims 14-15 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oi (JP 10-210072 A) in view of Duphorne (US PAT. 6,212,265).

Regarding claims 14-15, Oi differs from the claimed invention in not specifically teaching to store preferences selected by the user and to notify the user of the selected number of e-mails. However, Duphorne discloses a method for electronic mail notification comprising a parameter database (14c) for storing preferences selected by the user and filtering information to notify the user of a selected number of e-mails in order to make user friendly (col. 4 line 32 through col. 5 line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oi in storing preferences selected by the user

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and notifying the user of the selected number of e-mails, as per teaching of Duphorne, in order to make user friendly.

Regarding claims 32-33, the limitations of the claims are rejected as the same reasons set forth in claims 14-15.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gardell et al. (US PAT. 6,049,831) discloses a system for allowing users to received network information using a variety of devices (abstract). Quinn (US PAT. 5,944,786) discloses an automatic notification of receipt of electronic mail via telephone system without requiring log-on to e-mail server (abstract). Okubo et al. (JP 09-149148A) discloses an information terminal equipment capable of surely recognizing the reception of an electronic mail through a telephone line while viewing a television broadcasting by synthesizing a message for notifying the presence of the electronic mail with picture signals of the television broadcasting (abstract).

15. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(703) 872-9306 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

A handwritten signature in cursive script, appearing to read "George Eng".

George Eng

Primary Examiner

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